

REMARKS

I. Status of the Application

Claims 1, 3-6, 11-12, 15, 17-20, 25-26, 29, 31-34, 39-40, 43, 45-48, and 53-54 are pending.

II. Rejections

a. 35 U.S.C. 112

In the previous Office Action, the Examiner rejected claims 11, 25, 39, and 53 under 35 U.S.C. 112 as failing to comply with the written description requirement. The Examiner alleges that “canceling the selected bid or offer for the third item simultaneously with the shift of the price for the selected bids or offers” does not have support in the original disclosure. Applicants disagree. Support may be found at page 3, lines 1-10, which states:

Furthermore, the present invention may provide users with multiple bid/offer interactions. For example, a user may choose to simultaneously shift a price or a size of a plurality of bids and/or offers, simultaneously cancel a plurality of bids and/or offers, or simultaneously suspend and/or make active a plurality of bids and/or offers. The ability to apply changes to a plurality of bids and/or offers simultaneously may provide the user with time efficient bid/offer shifting.

From this passage, it is understood that various changes to a plurality of bids and/or offers may be applied simultaneously. Changes that may be performed simultaneously include price shifts, cancellations, and/or status changes, which fully supports cancelling a bid or offer (the third) while at the same time shifting the price of

other bids and/or offers (the first and second). Accordingly, withdrawal of the rejection is respectfully requested.

b. 35 U.S.C. 102 and 103

The pending claims were rejected either under 35 U.S.C. 102 as being anticipated by Ojha et al. (U.S. Patent 6598026) or under 35 U.S.C. 103 as being unpatentable over Ojha in view of at least one of Buist (U.S. Patent 6408282) or Navani et al. (U.S. Patent 20020049667). Applicants respectfully traverse.

With regard to claims 6, 20 34, and 48, the Examiner asserts that Navani discloses their features at paragraphs 0078-0079. Applicants submit that Navani is not prior art with regard to the paragraphs relied on by the Examiner. Specifically, paragraphs 0078-0079 do not have support in provisional application 60/230,840 from which Navani claims priority. Provisional application 60/230,840 appears to be a compilation of a slide show presentation and other documents that do not include all of the details of the later filed utility application. Therefore, the relevant date for these paragraphs is the filing of the Navani utility application or September 7, 2001. The present application's filing date is March 15, 2001, which predates the Navani utility application. Moreover, the features of claims 6, 20 34, and 48 are supported by provisional application from which the present application claims priority, which was filed on December 7, 2000.

Moreover, the Examiner asserts motivations to combine the cited references with regard to claims 4, 11-12, 15, 32, and 39-40 without any support for those assertions. In order to establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

combine teachings, there must be a reasonable expectation of success, and the prior art references must teach or suggest all of the claim elements. (In re Vaeck, 947 F.2d 488, 493 (Fed. Cir. 1991)). The suggestion or motivation proffered by the Examiner to modify a reference must be supported with substantial factual evidence in the record. (In re Lee, 277 F.3d 1338, 1342 (Fed. Cir. 2002); In re Zurko, 258 F.3d 1379, 1383-1386 (Fed. Cir. 2001); Novamedix Distrib., 175 F. Supp. 2d 8, 9 (D.D.C. 2001)). A conclusory or common sense statement as to the factual question of motivation must be supported by evidence in the record and without such evidence, the statement lacks substantial evidence support and is thereby insufficient to establish a *prima facie* case of obviousness. In re Lee, 277 F.3d at 1343-1345 (“[C]onclusory statements ... do not adequately address the issue of motivation to combine. ... [The] factual question of motivation is material to patentability, and [can] not be resolved on subjective belief and unknown authority.”); In re Zurko, 258 F.3d at 1385 (“This assessment of basic knowledge and common sense was not based on any evidence in the record and, therefore, lacks substantial evidence support.”).

As in In re Lee, the Examiner merely recites conclusory statements regarding the motivation to combine the references without any objective evidence supporting these statements. Moreover, the Examiner is silent with regard to the expectation of success. The Examiner has therefore failed to establish a *prima facie* case of obviousness with regard to at least claims 4, 11-12, 15, 32, and 39-40. Applicants demand that the Examiner provide a reference for the proffered motivation if the rejections are to be maintained.

Applicants submit that the remaining claims include features that further distinguish Applicants’ claimed invention from the art of record. Applicants reserve the right to argue those features at a later time.

III. Conclusion

Reconsideration and allowance of claims are therefore respectfully solicited. To expedite prosecution, the Examiner is invited to contact the Applicant's representative at 212-829-5407.

Respectfully submitted,

May 29, 2008

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